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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,088	11/14/2001	Jeffrey L. Trudeau	004608.00003	8571

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EXAMINER

PRIDY, MICHAEL B

ART UNIT PAPER NUMBER

3732

DATE MAILED: 08/12/2003

*3*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,088

Applicant(s)

TRUDEAU ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 45-48 and 51-53 is/are allowed.
- 6) ☐ Claim(s) 1, 4-11, 13, 18-24, 29, 35-39, 43, 49, 50 and 54 is/are rejected.
- 7) ☐ Claim(s) 2, 3, 12, 14-17, 25-28, 30-34, 40-42 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 11, 13, 18-23, 29, 35-39, 43 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandreid (U.S. 5,083,350). Sandreid teaches a clamp for clamping an elongate member 20 comprising: a housing 10 for receiving the elongate member 20, a saddle member 16 (means for engaging the elongate member in at least two positions) movably mounted relative to the housing 10; a platen 17 (means for engaging a substantial periphery of the elongate member) movably mounted relative to the housing 10; a lever 31 cooperating with the platen 17 for moving the saddle member 16 and platen 17 relative to the housing 10; and an engaging surface 18/19 for engaging the elongate member 20; wherein the lever 31 (means for selectively moving the platen and saddle member relative to the housing) is pivotably attached to the saddle member in a slot 34, the slot 34 being formed in the saddle member 16 and having at least two distinct positions (ends) allowing the lever 31 to pivot from at least two positions (one position shown in solid lines and the other in broken lines); wherein engaging surfaces 18/19 are associated with both the platen 17 and the saddle member 16 for engaging the member 20; wherein a portion of a lengthwise cross-section of the

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engaging surface is non-linear. The Examiner contends that any of the parts of the device of Sandreid are "associated" with any of the other parts of the device simply by being parts of the same device and further contends that the lever 31 of Sandreid is pivotably attached to the saddle member 16 through link 33. Considering the language "engage at least a portion of a periphery", it is the Examiner's belief that the engaging surfaces of Sandreid, while having tooth-like formations that may penetrate the periphery of the member 20, must engage some portion of the periphery at least around the point of penetration.

Claims 50 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. 5,312,410). Miller et al. teaches a method of clamping an elongate member in a medical device, as set forth in lines 45-68 of column 5 and lines 1-68 of column 6, comprising in combination the steps of: inserting an end of the elongate member 4 through the body 20 of a cable tensioner and clamping device housing; applying a clamping force to the elongate member using the clamping device and in so doing, engaging a periphery of the elongate member 4; and using the cable tensioner to apply tension to the elongate member 4.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 24 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandreid. Sandreid, as set forth in the above rejection under 35 U.S.C. 102(b), discloses the claimed invention except for a portion of a widthwise cross-section of the engaging surface is concave. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the engaging surface of the device of Sandreid with a widthwise cross-section having a concave shape, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a surface to engage a portion of the periphery of an elongate member. *In re Dailey and Eilers*, 149 USPQ 47 (1966)

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 5 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4 and 9 of U.S.

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Patent No. 6,378,289. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 4, 5 and 8 are anticipated by claims 1,4 and 9.

Claim 8, recites a clamp for clamping an elongate member comprising in combination: a housing for receiving the elongate member (line 3 of claim 1 of the patent); a saddle member movably mounted relative to the housing (lines 5-6 of claim 1 of the patent); a lever cooperating with the housing for moving the saddle member relative to the housing (lines 7-9 of claim 1 of the patent); and an engaging surface for engaging the elongate member (lines 10-11 of claim 1 of the patent); wherein the engaging surface is formed to engage at least a portion of a periphery of the elongate member (line 11 of claim 1 of the patent).

It is clear that all the elements of claim 8 are to be found in claim 1 of the patent. The difference between claim 8 of the present application and claim 1 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 1 of the patent is, in effect, a "species" of the "generic" invention of claim 8 of the present application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 8 is anticipated by claim 1 of the patent, it is not patentably distinct from that claim.

As to claim 4, note should be taken of the limitations of claim 4 of the patent.

As to claim 5, note should be taken of the limitations of claim 9 of the patent.

***All wable Subject Matter***

Claims 2, 3, 12, 14-17, 25-28, 30-34, 40-42 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 45-48 and 51-53 are allowed.

Each of claims 45-48 include the language "means for..." The examiner has interpreted each of these claims as invoking 35 U.S.C. 112, sixth paragraph which states that "a claim limitation expressed in means-plus-function language shall be construed to cover the corresponding structure... described in the specification and equivalents thereof." Therefore, with respect to claims 45-47, the Examiner has interpreted the means-plus-function language as corresponding to structure including at least a lever having one or more cam surfaces and with respect to claim 48, as corresponding to structure including a member which engages the periphery of an elongate member without penetrating the periphery.

***Conclusion***

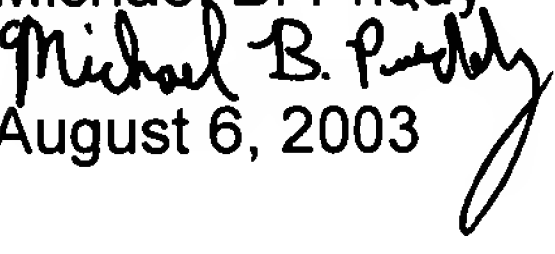
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy  
  
August 6, 2003